



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,197	06/21/2001	Shinichi Tsuboi	Mo5000ND/NIT-259-ND	9181

157 7590 06/26/2002

BAYER CORPORATION
PATENT DEPARTMENT
100 BAYER ROAD
PITTSBURGH, PA 15205

EXAMINER

ROBINSON, ALLEN JAY

ART UNIT PAPER NUMBER

1616

DATE MAILED: 06/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/886,197

Applicant(s)
Tsuboi et al.

Examiner
Allen J. Robinson

Art Unit
1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 30, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-21, 25, 29, and 30 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-21, 25, 29, and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 07/872,279.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6(2 sheets) 6) ☐ Other:

Art Unit: 1616

As per a restriction requirement made November 9, 2001, Applicants elected without traverse (paper number 5) methods of protecting technical material employing a combination of 1-(6-chloro-3-pyridylmethyl)-2-nitroimino-imidazolidine and tebuconazole.

The specific elected invention of the combination supra is clearly patentable distinct from another different and non-related combination such as the combination of 3-(6-chloro--3-pyridylmethyl)-2-nitromethylene-tetrahydro-2H-1,3-thiazine and dichlofluanide. The multitude of different combinations are non-related to each other, have different fields of search and can support separate patents. Therefore, the above restriction requirement is deemed proper, adhered to and made final. Cancellation of non-elected claims and subject matter from other claims is now required.

Claims 7-21, 25, 29 and 30 are acted upon on their merits to the extent that they read on the elected invention. The scope of the insecticide compounds will be examined as set forth in claim 7; and the scope of the azole fungicidal compounds will be examined as set forth in claim 25.

Claim Rejections - 35 USC § 103

Art Unit: 1616

Claims 7-21, 25, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiokawa et al. (AA), Worthing et al. (R) and European Patent 0148526 (L).

The Shiokawa et al. reference clearly teaches that the claim designated imidazolidine compounds are old insecticides applied to the same locus of the claims. Column 12, lines 50 and 51; and column 58, lines 30-35 teach the claim designated compounds. Column 54, lines 18-20 teaches the same locus (wood) as in the claim. Column 204, lines 19-32, teach that the active ingredients may be applied in a spray using a spray gun. Column 51, line 61; and column 52, lines 34-46 teach that the same insects as disclosed on pages 6 and 7 of the specification may be combated. Column 53, lines 60-67, teach that other active compounds, such as fungicides may be combined with the imidazolidine insecticides. The European Patent reference teaches that known azole fungicides, such as azaconazole are used to protect wood. The European Patent also teaches that insecticidal agents may be used in combination with the said azole fungicides.(page 7). The Worthing et al. reference teaches that the claim designated fungicides, such as tebuconazole, triadimefon and triadimenol are well known. The above references fail to teach specific examples of the old insecticides and old fungicides together. However, one skilled in this art would find ample motivation from the prior art supra to combine the well known insecticides and fungicides together, of known properties where the results obtained thereby are no more than the additive effects of the ingredients; particularly since the above prior art teaches the


Art Unit: 1616

combination of known insecticides and fungicides. In re Sussman, 1943 C.D. 518. The above prior art clearly renders the instant claims unpatentable.

References AB, AL-AN, AR, AS and AR'-AT' are cited to show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen J. Robinson whose telephone number is (703) 308-4524.

AJR
June 26, 2002


ALLEN J. ROBINSON
PRIMARY EXAMINER